

attorney may be forwarded to the PTO by mail or courier as the application papers provided the papers meet the formal requirements of § 1.52. Effective November 22, 1993, § 1.4 was amended to include a new paragraph (d) to specify that most correspondence filed in the PTO, which requires a person's signature, may be an original, a copy of an original or a copy of a copy. Only correspondence identified in §§ 1.4(e) and (f) require the original to be filed in the PTO. Thus, an oath or declaration required by § 1.63, 1.153, 1.162 or 1.175 may be an original, a copy of an original or a copy of a copy. See 1156 Off. Gaz. Pat. Office 61 (November 16, 1993).

**64. Comment:** One comment suggested that applicant be permitted to use § 1.62 procedure to file the 35 U.S.C. 111(a) application which claims the benefit of a provisional application, at least in those situations where the 35 U.S.C. 111(a) application has been converted to a provisional application which is followed by the filing of a second 35 U.S.C. 111(a) application.

**Response:** The suggestion has not been adopted. Section 1.62 will not be amended to permit the filing of a 35 U.S.C. 111(a) application based on a provisional application because the PTO sees this situation as a trap for applicants. The filing procedures would be made more complicated if an exception is provided to address situations where a 35 U.S.C. 111(a) application is converted to a provisional application and a second 35 U.S.C. 111(a) application is later filed. However, the suggestion will be taken under advisement when greater familiarity with provisional applications is developed.

**65. Comment:** One comment suggested that § 1.62 procedure be replaced with a simple petition procedure to reopen prosecution.

**Response:** The suggestion is not being adopted. However, the suggestion will be taken under advisement as part of a comprehensive effort being conducted by the PTO to reengineer the entire patent process.

**66. Comment:** One comment suggested that the language in § 1.62(a) that requires an identification of the "applicant's name of the prior complete application" is confusing and should be clarified.

**Response:** The suggestion has been adopted. Section 1.62 is being amended to require the identification of the "applicants named in the prior complete application."

**67. Comment:** One comment suggested that § 1.62 be amended to state that the refiling procedures set forth in § 1.62 may be used after the

issue fee is paid when a petition under § 1.313(b)(5) is granted. This practice is permitted pursuant to the notice published in 1138 Off. Gaz. Pat. Office 40 (May 19, 1992).

**Response:** The suggestion has been adopted.

**68. Comment:** One comment suggested that § 1.62 be amended to clarify whether applicant needs to re-list, in the § 1.62 application, all the references cited by the examiner and applicant in the parent application in order to get those references printed on the eventual patent.

**Response:** The suggestion has not been adopted. Section 609 of the MPEP (Sixth Edition, Jan. 1995) has been amended to clarify that in a § 1.62 application, references submitted and cited in the parent application need not be resubmitted. These references will be printed on the patent. However, in any continuing application filed under § 1.53(b)(1) or 1.60, a list of the references must be resubmitted if applicant wishes to have the references printed in the eventual patent.

**69. Comment:** One comment suggested that § 1.67 should go into more detail on when supplemental oaths are required in § 1.53 filings of continuation and divisional applications.

**Response:** The suggestion has been adopted because it is seen to be unnecessary and no substantive change was proposed to § 1.67 in the Notice of Proposed Rulemaking.

**70. Comment:** One comment suggested that "not but" in § 1.67(b) should read "but not".

**Response:** The suggestion has been adopted.

**71. Comment:** Several comments suggested that a rule be provided to state that an application for patent is permitted to claim the benefit of the filing date of more than one prior provisional application so long as the applicant complies with all statutory provisions.

**Response:** The suggestion has been adopted. Section 1.78(a)(3) is being amended to indicate that applicants are permitted to separately claim the benefit of the filing date of more than one prior provisional application in a later filed 35 U.S.C. 111(a) application provided all statutory requirements of 35 U.S.C. 119(e) are complied with. It is noted that current practice permits an application to claim the benefits of the filing date of more than one prior foreign application under 35 U.S.C. 119(a)-(d) and of more than one prior copending U.S. application under 35 U.S.C. 120, without an explicit statement to that effect in the rules.

Since the final rules are being amended to specifically permit applications filed under 35 U.S.C. 111(a) to claim the benefits of the filing date of more than one prior copending provisional application, corresponding changes are also being made to §§ 1.55 and 1.78(a)(1) relating to claims for the benefits available under 35 U.S.C. 119(a)-(d) and 120 to be consistent with § 1.78(a)(3).

**72. Comment:** Several comments requested that the PTO specify language to use in the first sentence of an application when priority is based on more than one provisional application.

**Response:** Section 1.78(a)(4) requires that "any application claiming the benefit of a prior filed copending provisional application must contain or be amended to contain in the first sentence of the specification following the title a reference to such prior provisional application, identifying it as a provisional application, and including the provisional application number." Where a 35 U.S.C. 111(a) application claims the benefit of more than one provisional application, a suitable reference would read, "This application claims the benefit of U.S. Provisional Application No. 60/—, filed — and U.S. Provisional Application No. 60/—, filed —." In addition, for an application which is claiming the benefit under 35 U.S.C. 120 of a prior application, which in turn claims the benefit of a provisional application under 35 U.S.C. 119(e), a suitable reference would read, "This application is a continuation of U.S. application No. 08/—, filed —, now abandoned, which claims the benefit of U.S. Provisional Application No. 60/—, filed —."

**73. Comment:** One comment suggested that the rules address the effect on patent term where an applicant in a continuing application deletes the reference to the prior filed application before the patent issues.

**Response:** an applicant has full control over claims to the benefit of an earlier filing date under 35 U.S.C. 120, 121 or 365(c). The 20-year patent term will be based upon the filing date of the earliest U.S. application that the applicant makes reference to under 35 U.S.C. 120, 121 and 365(c). Whether an applicant is entitled to the benefit of the filing date of an earlier application is something that an applicant should examine before the patent is issued. The PTO is not, unless it comes up as an issue in the examination process, going to determine whether any of the claims are entitled to the earlier filing date. Applicant however, should determine whether the claims are entitled to or require the benefit of the earlier filing